

### REMARKS/ARGUMENTS

Claims 37-42 are pending. Claims 43-51 are canceled without prejudice to their presentation in another application. Claim 40 is amended.

Claims 40-42 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly failing to distinctly claim the invention. Although applicants do not agree with this allegation, claim 40 is amended to further prosecution. The definition of "percent bioavailability" is presented at page 28, lines 13-15 and is reflected in the amended claim. This amendment is believed to remove any clarity allegations without altering the scope of the claim. Applicants respectfully request reconsideration and withdrawal of the rejection.

Claims 37, 38, 40, and 41 are rejected as allegedly anticipated by U.S. Patent No. 5,744,460 (the Muller patent). Applicants request reconsideration of this rejection because the Muller patent does not describe any claimed invention in a way that would place it in the possession of those skilled in the art. *In re Arkley*, 172 U.S.P.Q. 524, 528 (CCPA 1972) ("The test which determines whether an invention has been anticipated by a reference is whether the description of the invention in the reference is sufficient to put the public in possession of the invention.") The Muller patent presents many options for compositions that are said to have the ability to hybridize to PKC and show increased stability. To arrive at any claimed invention, one skilled in the art would have to engage in picking and choosing from among the variables presented at column 7, line 52 to column 8, line 57 of the Muller patent. The need for such picking and choosing, however, is plainly inconsistent with a finding of anticipation. *Id.*, 172 U.S.P.Q. at 526; *In re Schaumann*, 572 F.2d 312, 314 (C.C.P.A. 1978) ("By having to select [a variable] from among the many possibilities which R in the structural formula [of the reference] may be, . . . does not give rise to the claimed compound being fully anticipated by the reference."). As such, applicants respectfully request reconsideration and withdrawal of the rejection.

Claims 37-42 stand rejected under 35 U.S.C. § 103 as allegedly being obvious in view of the combined teaching of the Muller patent and U.S. Patent No. 5,591,721 (the Agrawal patent). The Office Action, however, fails to identify any motivation of the proposed combination. Before a rejection for alleged obviousness can be predicated on a "combination of references," some motivation to combine the teachings of the prior art must

be identified. An invention is not obvious under the patent laws simply because it is theoretically possible with the aid of hindsight to combine references in a manner that will yield the claimed invention. The prior art itself must suggest the desirability of the modification. *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). "A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field." *In re Kotzab*, 217 F.3d 1365, 1369, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000). "The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time." *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) (quoting *Interconnect Planning Corp. v. Feil*, 774 F. 2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985)). To establish a *prima facie* case of obviousness, "there must be some teaching, suggestion or motivation in the prior art to make the specific combination that was made by the applicant." *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998). "In other words, the examiner must show reasons that the skilled artisan, confronted with the same problem as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998).

The Office Action does not identify any reason why one skilled in the art would have combined the teachings of the cited references in a way that would have produced a claimed invention. As discussed above, one must engage in picking and choosing to arrive at any claimed invention. For example, the Muller reference discloses numerous internucleoside linkages (*see, e.g.*, column 8, lines 19-57), and there is no evidence of record indicating that those of ordinary skill would have regarded the claimed methylene(methylimino) (MMI) linkages as preferred for administration to the alimentary canal. Without such motivation, MMI linkages are merely one of many possibilities presented. The Agrawal patent does not cure this defect. In fact, the Agrawal patent does not even address compositions with MMI linkages (*see, for example*, column 3, lines 49-64 and column 7, lines 5-13). Thus, even if one were motivated to combine the cited references in some manner, the particular way in

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**PATENT**

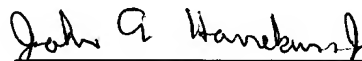
which one would have needed to combine them to produce a claimed invention would not have been obvious.

Furthermore, as acknowledged by the Office Action (page 6), nothing in the cited art discloses the use of alternating MMI and phosphodiester internucleoside linkages. Although the Office Action alleges that the disclosure of various linkages in the cited art would have motivate one to incorporate "various configurations of modified internucleotide linkages" (page 6), the Office Action does not identify any motivation for one of ordinary skill to have selected the specific alternating motif of the instant claims. Without such motivation, the instant claims simply cannot be found obvious. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection.

Applicants believe that the foregoing constitutes a complete and full response to the Office Action of record. Accordingly, an early and favorable reconsideration of the rejections and an allowance of all of pending claims is earnestly solicited.

Respectfully submitted,

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